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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,745	01/23/2004	David F. MacNeil	301700-000066	7637

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EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,745	Applicant(s) MACNEIL, DAVID F.	
	Examiner Brian K. Green	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,7,8 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,7,8 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Dec. 6, 2005 has been entered.

Drawings

Labeling the drawing sheet filed Dec. 6, 2005, which includes Fig. A, Fig. B, and Fig. C, as a "Replacement Sheet" is improper. If the applicant wants to add this new drawing sheet into the application then the sheet should include "New Sheet" in the top margin. The addition of Figs. A and B are considered new matter. Further, it appears that the applicant submitted this drawing sheet as an "Exhibit" to show the differences between the prior art and the applicant's invention. The new drawing sheet has not been entered into the application as a "Replacement Sheet" and is being considered as an "Exhibit" to show the differences between the prior art and the applicant's invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7,19,20, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of Hensien (U.S. Patent No. 3,231,288).

Leopold et al. shows in figures 1-3 a transparent frame (2) having a front, a periphery, an outer side and an inner side for disposal adjacent a license plate (4), a plurality of holes (6), and a rubber gasket (10). Each hole including a sidewall of nongasket material extending from the outer side of the frame to the inner side of the frame. Leopold et al. does not disclose making the sidewall of each hole extend inwardly to a plane containing the receiving surface of the gasket. Hensien shows in figures 1 and 2 the idea of having the sidewall of a hole extend inwardly to a plane containing the receiving surface of a gasket by including a nongasket material element (17 and 18) or just element (23, see column 2, lines 25-30). In view of the teachings of Hensien it would have been obvious to one in the art to modify Leopold et al. by making the sidewall extend from the outer side of the frame to the inner side of the frame since this would prevent the gasket from being overtightened and damaged. In regard to claim 19, the generally vertically extending portion of the gasket is considered to be the compression rib. In regard to claim 20, Leopold et al. shows in figure 2 that the openings are stepped. In regard to claim 4, Leopold et al. shows in figures 3 and 4 that the compression rib is V-shaped.

Claims 19,4, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of Hensien (U.S. Patent No. 3,231,288) as

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applied in claim 7 above and further in view of Dutt (U.S. Patent No. 4,308,965) or Dutt (U.S. Patent No. 4,461,393).

In regard to claim 19, the examiner is interpreting Leopold et al. in a second way in which the Leopold et al. patent is not considered to include a compression rib. Leopold et al. in view of Hensien disclose the applicant's basic inventive concept except for providing at least one compression rib on the inner surface of the gasket. Dutt shows in figures 1-5 a cover (10), an elastomeric gasket (16 or 20 or 50), and the gasket inner surface includes first and second ribs. Dutt '393 shows in figures 1-2 a cover (12), an elastomeric gasket (22), and the gasket inner surface includes first and second ribs. In view of the teachings of Dutt it would have been obvious to one in the art to modify Leopold et al. by attaching a rib on the inner surface of the gasket since this would allow the transparent frame to be sealed to the license plate in a better manner. In regard to claim 3, Leopold et al. does not disclose the use of a rim. Dutt '965 shows in figures 4 and 5 the use of first and second ribs and Dutt '393 shows in figures 1 and 2 first and second ribs. The outer rib being considered to be a raised rim. In view of the teachings of Dutt or Dutt '393 it would have been obvious to one in the art to modify Leopold et al. by providing a second rib/raised rim since this would further improve the seal between the transparent frame and license plate. In regard to claim 4, Dutt and Dutt '393 show that the ribs are V-shaped. In regard to claim 21, Leopold does not disclose placing an elongated channel within the frame and placing a portion of the gasket within the channel. Dutt '965 shows in figures 1-5 and Dutt '393 shows in figures 1-2, the idea of placing a channel within the frame and placing a portion of the gasket within the channel. In view of the teachings of Dutt or Dutt '393 it would have been obvious to one in the art to modify Leopold et al. by placing a channel

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within the frame and placing a portion of the gasket within the channel since this would allow the gasket to be attached to the frame in a more secure manner. Dutt '965 discloses the idea of injection molding the gasket.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of Hensien (U.S. Patent No. 3,231,288) and Dutt (U.S. Patent No. 4,308,965) or Dutt '393 as applied in claim 19 above and further in view of Yip (U.S. Patent No. 6,302,782).

Leopold et al. in view of Hensien and Dutt or Dutt '393 disclose the applicant's basic inventive concept except for making the rib discontinuous. Yip shows in figure 2 the idea of making a gasket (21) discontinuous in order to allow water to drain out. In view of the teachings of Yip it would have been obvious to one in the art to modify Leopold et al. by making the gasket discontinuous since this would allow water to drain out from the license plate assembly.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of Hensien (U.S. Patent No. 3,231,288) as applied in claim 19 above and further in view of Yip (U.S. Patent No. 6,302,782).

Leopold et al. in view of Hensien disclose the applicant's basic inventive concept except for making the rib discontinuous. Yip shows in figure 2 the idea of making a gasket (21) discontinuous in order to allow water to drain out. In view of the teachings of Yip it would have been obvious to one in the art to modify Leopold et al. by making the gasket discontinuous since this would allow water to drain out from the license plate assembly.

Claims 19 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of Hensien (U.S. Patent No. 3,231,288) as applied in claim 7 above and further in view of Roselli (U.S. Patent No. 4,546,986).

In regard to claim 19, the examiner is interpreting Leopold et al. in a second way in which the Leopold et al. patent is not considered to include a compression rib. Leopold et al. in view of Hensien disclose the applicant's basic inventive concept except for providing at least one compression rib on the inner surface of the gasket. Roselli shows in figures 2 and 3 a cover (1), an elastomeric gasket (6 or 12), and the gasket inner surface includes first and second ribs. In view of the teachings of Roselli it would have been obvious to one in the art to modify Leopold et al. by attaching a rib on the inner surface of the gasket since this would allow the transparent frame to be sealed to the license plate in a better manner. In regard to claim 3, Leopold et al. does not disclose the use of a rim. Roselli shows in figures 2 and 3 the use of first and second ribs. The outer rib being considered to be a raised rim. In view of the teachings of Roselli it would have been obvious to one in the art to modify Leopold et al. by providing a second rib/raised rim since this would further improve the seal between the transparent frame and license plate.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but some of the arguments are moot in view of the new ground(s) of rejection.

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The applicant argues that the process of injection molding yields a product which is physically different and therefore the examiner must give weight to this language in claim 21. The Dutt patent discloses the idea of injection molding the gasket, see column 2, lines 27-31.

The applicant argues that Dutt does not disclose the use of a compression rib. The examiner disagrees since Dutt shows in figures 4 and 5 that the ribs are compressed to a certain degree.

The applicant argues that Dutt fails to show a planar receiving surface facing generally toward the license plate. The examiner disagrees since Dutt shows in figure 4 that the gasket includes two planar surfaces (the inner surfaces which engage the bottle or jar 12).

The applicant argues that putting a rib on the Leopold et al. gasket would defeat its ability to seal the convex license plate bead. The examiner disagrees since the gasket of Dutt would improve the sealing of the license plate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg
Feb. 13, 2006


BRIAN K. GREEN
PRIMARY EXAMINER